

REMARKS

Applicant respectfully requests that the application be reconsidered in view of following remarks. In the Office Action, dated April 25, 2005, the Examiner objected to claim 31 as being dependent from a canceled claim. The Examiner additionally rejected claims 1-4, 7, 11 and 12 under 35 U.S.C. § 102(b) as allegedly being anticipated by U. S. Patent No. 6,371,691 (hereinafter "FINZEL"). The Examiner also rejected claims 6 and 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over FINZEL. The Examiner further rejected claims 23, 24, 28, 29, 31 and 32 under 35 U.S.C. §103(a) as allegedly being unpatentable over FINZEL in view of U.S. Patent Publication No. 2003/0068143 (hereinafter "MARTINEZ"). The Examiner additionally rejected claims 8-10 under 35 U.S.C. §103(a) as allegedly being unpatentable over FINZEL in view of U.S. Patent No. 4,554,724 (hereinafter "BANTZ"). The Examiner also rejected claims 25 and 26 under 35 U.S.C. §103(a) as allegedly being unpatentable over FINZEL in view of MARTINEZ and BANTZ. Reconsideration of the outstanding rejection of pending claims 1-4, 6, 7, 9-13, 23, 24, 26, 28, 29, 31 and 32 is respectfully requested in view of the following remarks.

In paragraph 2, the Office Action objects to claim 31 as being dependent upon a canceled claim. In the After-final amendment, filed March 23, 2005, Applicant amended claim 31 to depend from claim 23. According to paragraph 3 of the Office Action, this after-final amendment appears to have been entered by the Examiner. In view of this change in dependency, Applicant respectfully requests withdrawal of the objection to claim 31.

In paragraph 5, the Office Action rejects claims 1-4, 7, 11 and 12 under 35 U.S.C. 102(b) as allegedly being anticipated by FINZEL. Applicant respectfully traverses.

Claim 1 recites a method that includes “cutting a trench in a surface of the roadway,” “placing a duct in the trench,” “placing a spacer within the trench on top of the duct,” “filling the trench with a sealer,” “placing a first cable within the duct,” “pulling the first cable out of, and through, the duct” and “placing a second cable within the duct without removing the sealer within the trench.”

A proper rejection under 35 U.S.C. § 102 requires that a reference teach each and every feature of the claimed invention. See M.P.E.P. § 2131. Applicant respectfully submits that FINZEL does not disclose or suggest each and every feature of claim 1.

For example, FINZEL does not disclose or suggest “placing a first cable within the duct,” “pulling the first cable out of, and through, the duct” and “placing a second cable within the duct without removing the sealer within the trench,” as recited in claim 1. The Examiner relied on column 26, lines 4 -21 of FINZEL for allegedly teachings these features (Office Action, pg. 3). Applicant respectfully submits that this section, or any other portion, of FINZEL does not disclose or suggest the above cited features.

Column 26, lines 4 – 21 of FINZEL discloses the following:

FIG. 54 shows the cross-section through an elongate profile body VP comprising a solid profile which has elastic properties, but cannot be deformed plastically. The profile body is fixed in the laying channel by elastic barbs WH. Arranged within the profile body VP are longitudinally running free ducts FK into which fibres can be drawn or blown at a later point in time. Provided in the upper region of the profile body VP is a duct for a microcable MK which is introduced into the profile body VP in the direction GR, through a longitudinally running slit VPS, before the laying operation.

FIG. 55 shows the profile body VP of FIG. 54 within the laying channel VN, the

elastic barbs WH having been wedged along the channel wall. Additional optical waveguides may possibly be drawn or blown into the free ducts FK of the profile body VP at a subsequent point in time. The upper part of the laying channel VN is, once again, filled with a sealant B.

The above cited section of FINZEL, thus, discloses the drawing or blowing of optical fibers into free ducts FK of a profile body VP after laying the profile body VP into a channel in the ground. This section of FINZEL, however, does not disclose, or even suggest, “pulling the first cable out of, and through, the duct” and “placing a second cable within the duct without removing the sealer within the trench,” as recited in claim 1.

In other sections not cited by the Office Action, FINZEL discloses the laying of a tubular “mini-cable,” containing optical waveguides or conductors, within a trench cut into sand, gravel, earth, or asphalt (column 8, lines 27-44). Once the mini-cable containing the optical waveguides or conductors is laid, FINZEL discloses filling the trench with a material, such as bitumen (column 10, 40-41). To repair the optical waveguides or conductors placed in the mini-cable, FINZEL discloses that the material filled in the trench must be removed so that the mini-cable can be lifted out of the trench (column 24, line 66 through column 25, line 2; column 25, line 55 through column 26, line 3; column 4, lines 31-34). These other sections of FINZEL, thus, do not disclose, or even suggest, removal of the optical waveguide or conductor from the mini-cable and placing a repaired optical waveguide or conductor, or a new optical waveguide or conductor, back within the mini-cable *without removing the material from the trench*. FINZEL, thus, does not disclose “placing a first cable within the duct,” “pulling the first cable out of, and through, the duct,” and “placing a second cable within the duct without removing the sealer within the trench,” as recited in claim 1. Since FINZEL does not suggest or disclose the combination of

features recited in claim 1, FINZEL cannot anticipate claim 1 and, therefore, withdrawal of the rejection of claim 1 is respectfully requested.

Claims 2-4, 7, 11 and 12 depend from claim 1 and, therefore, patentably distinguish over FINZEL for at least the reasons set forth above with respect to claim 1.

In paragraph 7, the Office Action rejects claims 6 and 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over FINZEL. In rejecting claims 6 and 13, the Office Action alleges that the features of claim 6 were well known, and that the features of claim 13 were inherent and anticipated (Office Action, pgs. 4-5). Applicant submits, however, that the Office Action's allegations do not remedy the deficiencies in the disclosure of FINZEL noted above with respect to claim 1, from which claims 6 and 13 depend. Withdrawal of the rejection of claims 6 and 13 is, therefore, respectfully requested for at least the reasons set forth above with respect to claim 1.

In paragraph 8, the Office Action rejects claims 23, 24, 28, 29, 31 and 32 under 35 U.S.C. §103(a) as allegedly being unpatentable over FINZEL in view of MARTINEZ. Applicant traverses and submits that the Office Action has failed to make out a *prima facie* case of obviousness.

As one requirement for establishing a *prima facie* case of obviousness, the reference (or references when combined) cited by the Office Action must teach or suggest all of the claim features. *In re Vaeck*, 947 F.2d 488, U.S.P.Q.2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 2143. Applicant respectfully submits that the references cited by the Office Action, either singly or in combination, do not teach or suggest each and every feature of claim 23.

Claim 23 recites a method that includes "cutting a trench into the concrete or asphalt to a

depth of approximately 3.5 to 4.0 inches from a surface of the concrete or asphalt,” “placing a tubular material having a hollow inner diameter within the trench,” “placing a spacer on top of the tubular material, wherein the spacer comprises a water impermeable, heat resistant material,” “filling at least a portion of the trench with a sealer,” “placing a first cable within the tubular material,” “removing the first cable from the tubular material without removing the sealer from the trench” and “placing a second cable within the tubular material without removing the sealer from the trench.”

In rejecting claim 23, the Office Action admits that FINZEL does not disclose “removing the first cable from the tubular material without removing the sealer from the trench,” as recited in claim 1. The Office Action, however, alleges that MARTINEZ discloses a “method for providing fiber optic cable through existing service lines wherein a first cable is pulled out and a second one installed without removing overlying earth” (Office Action, pg. 6). The Office Action further alleges that “it would have been obvious to one having ordinary skill in the art of cable laying...to modify the method disclosed by FINZEL ‘691 such that the first cable would be pulled without removing the sealer as suggested by MARTINEZ” (Office Action, pg. 6). Applicant respectfully traverses these allegations of the Office Action.

MARTINEZ discloses the use of flexible tubes for installing fiber optic cables through existing service pipes (see Abstract). As disclosed in paragraph [0010] of MARTINEZ, the problem that MARTINEZ is attempting to solve is the inability of conventional techniques to pull fiber optic cables through gas service pipes. Service pipes, generally, have been recognized in the art as a means of laying optical cable without having to dig additional trenches in the ground (see paragraphs [0006] and [0007]) for placement of the optical cable. MARTINEZ,

however, recognizes that existing systems for laying optical cable through service pipes may not work effectively for smaller service pipes, such as gas service pipes (see paragraph [0009]).

MARTINEZ, thus, discloses a technique for installing optic fiber in a gas service pipe that includes feeding a flexible tube through an already buried gas service pipe, and installing fiber optic cables through the flexible tube (see paragraph [0013]). MARTINEZ, therefore, discloses the use of a flexible tube for installing an optic cable through a gas service pipe. Since the gas service pipes of MARTINEZ are already buried in the ground prior to installing the fiber optic cables, the technique of MARTINEZ, thus, has nothing to do with the removal of a cable from a tubular material placed in a trench without removing the sealer from the trench in which the tubular material is placed, as recited in claim 23. MARTINEZ merely discloses the installation and removal of fiber optic cables from gas service pipes and does not disclose "removing the first cable from the tubular material without removing the sealer from the trench," as recited in claim 23. FINZEL and MARTINEZ, therefore, singly or in combination do not disclose the combination of features recited in claim 23. Withdrawal of the rejection of claim 23 is respectfully requested for at least this reason.

Another requirement for establishing a *prima facie* case of obviousness is that there must be some reason, suggestion, or motivation to combine reference teachings. *In re Vaeck*, 947 F.2d 488, U.S.P.Q.2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 2143. Applicant respectfully submits that the Office Action has not provided a sufficient reason, suggestion, or motivation for combining the disclosure of MARTINEZ with the disclosure of FINZEL.

In support of the rejection of claim 23, the Office Action alleges that "it would have been obvious to one having ordinary skill in the art of cable laying...to modify the method disclosed

by FINZEL '691 such that the first cable would be pulled without removing the sealer as suggested by MARTINEZ" to "prevent disruption of the roadway" (Office Action, pg. 6). As discussed above, however, MARTINEZ discloses the use of a flexible tube for installing an optic cable through a *gas service pipe which is already buried in the ground*. MARTINEZ discloses the installation of optic fibers through gas service pipes for the purpose of avoiding the need to excavate additional trenches in the ground that would be required to bury optic cables using conventional techniques (see paragraphs [0006] and [0007]). Since the gas service pipe is already buried in the ground, and installation and removal of the optic fiber can occur through the already buried gas service pipe, the disruption of the roadway is not even an issue with respect to the installation or removal of optical cables in MARTINEZ. Since, in the technique of MARTINEZ, there is no need to excavate trenches when installing a cable through a gas service pipe, one skilled in the art would not be motivated to combine the disclosure of MARTINEZ with the disclosure of FINZEL for the alleged purpose of "preventing disruption of the roadway." Withdrawal of the rejection of claim 23 is respectfully requested for at least this additional reason.

Claims 24, 28, 29 and 31 depend from claim 23. Withdrawal of the rejection of these claims is respectfully requested for at least the reasons set forth above with respect to claim 23. Applicant further submits that the disclosure of MARTINEZ does not remedy the deficiencies in the disclosure of FINZEL noted above with respect to claim 1, from which claim 32 depends. Withdrawal of the rejection of claim 32 is, therefore, respectfully requested for at least the reasons set forth above with respect to claim 1.

In paragraph 9, the Office Action rejects claims 8-10 claims under 35 U.S.C. §103(a) as allegedly being unpatentable over FINZEL in view of BANTZ. Applicant notes that claim 8 has previously been canceled and, therefore, the rejection of this claim is moot. The Office Action cites BANTZ for allegedly disclosing a tubular spacer placed in a trench above a series of ducts (Office Action, pg. 7). Applicant submits, however, that BANTZ does not remedy the deficiencies in the disclosure of FINZEL noted above with respect to claim 1, from which claims 9 and 10 depend. Withdrawal of the rejection of claims 9 and 10 is, therefore, requested for at least the reasons set forth with respect to claim 1 above.

In paragraph 10, the Office Action rejects claims 25 and 26 under 35 U.S.C. §103(a) as allegedly being unpatentable over FINZEL in view of MARTINEZ and BANTZ. Applicant notes that claim 25 has previously been canceled and, therefore, the rejection of this claim is moot. The Office Action cites BANTZ for allegedly disclosing a tubular spacer of water impermeable, heat resistant material (Office Action, pg. 8). Applicant submits, however, that BANTZ does not remedy the deficiencies in the disclosure of FINZEL and MARTINEZ noted above with respect to claim 23, from which claim 26 depends. Withdrawal of the rejection of claim 26 is, therefore, requested for at least the reasons set forth with respect to claim 23 above.

In view of the foregoing remarks, Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 13-2491 and please credit any excess fees to such deposit account.

Respectfully submitted,



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